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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/544,349	04/06/2000	William C. Bornhorst	5282USA	8014

7590 12/18/2002

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EXAMINER
CORBIN, ARTHUR L

ART UNIT	PAPER NUMBER
1761	10

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/544,349	BORNHORST ET AL
Examiner	**Group Art Unit**
ARTHUR L. CORBIN	1761

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 9-13-02, 10-1-02.

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-15, 17-41 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-15, 17-41 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)–(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)–(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO–1449, Paper No(s). _____

☐ Interview Summary, PTO–413

☐ Notice of Reference(s) Cited, PTO–892

☐ Notice of Informal Patent Application, PTO–152

☐ Notice of Draftsperson's Patent Drawing Review, PTO–948

☐ Other _____

Office Action Summary

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-15 and 17-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,291,008. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasoning set forth in paragraph No. 5, Paper No. 5.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-3, 5-10, 12-15, 17-27 and 29-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB Patent 1,050,307.

Applicant is referred to the reasoning set forth in paragraph No. 7, Paper No. 5.

5. Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the GB patent as applied to claims 1-3, 5-10, 12-15, 17-27 and 29-41 above, and further in view of Matz.

Applicant is referred to the reasoning set forth in paragraph No. 8, Paper No. 5.

6. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over the GB patent as applied to claims 1-3, 5-10, 12-15, 17-27 and 29-41 above, and further in view of Schwab et al.

Applicant is referred to the reasoning set forth in paragraph No. 9, Paper No.5.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-8, 10-14, 22, 25, 26, 28-31 and 41 are also rejected under 35 U.S.C. 102(a) as being clearly anticipated by Robie et al (WO 99/41998). Applicant is referred to paragraph No. 8, Paper No. 7.

9. Claims 1-8, 10-14, 22, 25, 26, 28-31, 38 and 41 are further rejected under 35 U.S.C. 102(e) as being clearly anticipated by Robie et al (6,291,008).

Applicant is referred to paragraph No. 9, Paper No. 7.

10. Claims 9, 15, 17-21, 23, 24, 27, 32-37, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Robie et al patent.

Applicant is referred to paragraph No. 10, Paper No. 7.

11. Applicant's arguments filed September 13, 2002 have been fully considered but they are not persuasive. Applicant's two step cooking still does not distinguish over the single step cooking in the British patent since applicant's second cooking step is merely an extension of the first cooking step inasmuch as the first cooking step does not recite any cooking parameters. Thus, applicant's first cooking step could be performed under the same conditions as applicant's second cooking step. Also, the second cooking step could be performed in the same cooker-extruder as the first cooking step. Applicant can distinguish the claimed cooking steps by reciting "at a temperature sufficient to gelatinize the cereal starch present in the grain pieces" after "step" (claim 1, line 6). This limitation is found on page 10, lines 26-27 of applicant's specification.

The Robie et al patents are available as prior art since applicant's claims are not fully supported by 6,291,008. Many of these unsupported limitations are ranges, some points within each range being disclosed by the Robie et al patents. Other claims are not fully supported because they contain alternative language or Markush groups, some parts of which are disclosed by the Robie et al patents, which is sufficient to anticipate such claims.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication from the examiner should be directed to Arthur Corbin whose telephone number is (703) 308-3850. The examiner can generally be reached on Tuesday--Friday from 10 a.m. to 7:30 p.m. and on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703) 308-3929. The fax phone numbers for the organization where this application is assigned are (703) 872-9310 for regular communications and (703) 305-7115 for After Final communications.

Any inquiry of a general nature to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0661.

A. Corbin/dh
December 13, 2002

ARTHUR L. CORBIN
PRIMARY EXAMINER
12-16-02